



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/400,817	09/22/99	KOCH	J 01994005001

CELIA H LEBER
FISH & RICHARDSON
225 FRANKLIN STREET
BOSTON MA 02110-2804

QM32/0828

EXAMINER

BROWN, M

ART UNIT

PAPER NUMBER

3764

DATE MAILED:

08/28/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/400,817

Applicant(s)

James P. Koch

Examiner

Michael Brown

Group Art Unit

3764

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☐ Responsive to communication(s) filed on _____.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-40 is/are pending in the application.
Of the above claim(s) _____ is/are withdrawn from consideration.
- ☒ Claim(s) 28-32 is/are allowed.
- ☒ Claim(s) 1-2, 5-7, 11-27, 33-36 and 39-40 is/are rejected.
- ☒ Claim(s) 3-4, 8-10 and 37-38 is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____.
 - ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

Art Unit: 3764

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-40 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no description of figures 6a-6c.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-2, 5-7, 11 and 33-36 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Koch '064.

Art Unit: 3764

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 12-27 and 39-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koch '064 in view of Mohajer.

Koch discloses in figures 1-7 a cervical cap and kit, substantially as claimed. However, Koch does not disclose a therapeutic agent coated or impregnated into the cervical cap or a cervical plunger. Mohajer teaches in figures 1-8 a cervical cap comprising a therapeutic agent that can be impregnated into the cervical cap (the cap can be made of an absorbent material, consequently the agent would be impregnated into the cap) and a plunger (fig. 4). It would have been obvious to one having ordinary skill in the art at the time that the invention was made the therapeutic agent as taught by Mohajer could be incorporated into the cervical cap disclosed by Koch in order to use the agent to prevent conception. The plunger could be used to insert the cervical cap into the vagina. It is old and well known in the art to use a therapeutic agent that is an iodine complex.

Art Unit: 3764

Allowable Subject Matter

7. Claims 3-4, 8-10 and 37-38 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
8. Claims 28-32 are allowed.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Koch '804 discloses a cervical cap. Shields discloses a cervical cap. Although each of these references discloses structural limitations recited in the claims, neither was used to reject any claims, in the first office action.
10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Brown whose telephone number is (703) 308-2682.

M. Brown
August 24, 2000



Michael A. Brown
Primary Examiner